Supreme Court, U.S.
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No.

In The

Supreme Court of the United States

October Term, 1997

IN RE ROBERT LONARDO and
RESTORATIVE CARE OF AMERICA, INC.

On Petition for a Writ of Mandamus to the United States Court of Appeals for the Federal Circuit

PETITION FOR A WRIT OF MANDAMUS

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QUESTION PRESENTED

I. Whether the Federal Circuit breached its duty to render a complete judgment when it refused to decide the issue of whether patent reexamination can be broadened beyond the new question of patentability set forth in the reexamination order of 35 U.S.C. § 304.

RULE 29.6 STATEMENT

Restorative Care of America Incorporated has no parent company, and there are no non-wholly owned subsidiaries.

OPINIONS BELOW

The July 8, 1997 decision of the Federal Circuit Court of Appeals is reported at 119 F.3d 960 (Fed. Cir. 1997), and is reprinted as Appendix A in this petition. The August 29, 1997 order of the Federal Circuit denying rehearing or rehearing *en banc* is reprinted as Appendix E. The March 2, 1998 order of the Supreme Court denying certiorari is reprinted as Appendix F.

STATEMENT OF JURISDICTION

Jurisdiction of this Court is invoked pursuant to 28 U.S.C. § 1651(a).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

This petition involves 28 U.S.C. § 1651.

28 U.S.C. § 1651. Writs

> (a) The Supreme Court and all courts established by Act of Congress may issue all writs necessary or appropriate in aid of their respective jurisdictions and agreeable to the usages and principles of law.

STATEMENT OF THE CASE

Restorative Care of America Incorporated (RCAI) is the assignee from the inventor Robert Lonardo of U.S. patent 5,298,013 ('013). The '013 patent relates to a therapeutic leg and foot device.

In 1994, at the request of third parties, reexamination of the '013 patent was ordered on the basis of a new question of

patentability over the Baker U.S. Patent 3,527,209. (App. 8a). After confirming that Baker did not invalidate the '013 claims, the Patent Office Examiner extended the scope of the reexamination beyond the new question of patentability and rejected the claims on a *new* issue of double patenting. (App. 8a). The Board of Patent Appeals and Interferences affirmed the Examiner's rejection of the '013 patent on the ground of double patenting over the Re 33,762 patent. (App. 9a).

Petitioner appealed, in part, asking that the Federal Circuit reverse the decision because the reexamination statutes do not permit the Examiner to decide any issue other than the question of patentability specifically set forth in the reexamination order. (App. 24a; *see also* 35 U.S.C. § 304). The Federal Circuit affirmed the Patent Office Board of Appeals and Interferences, but did not decide this issue which was squarely before the Court on appeal. A favorable decision on this issue would have required a reversal on appeal of the Board's decision on the '013 patent.

Petitioner again requested the Federal Circuit to decide this issue by petition for rehearing or rehearing *en banc*, (App. 25a) and the Court refused to do so without comment. (App. 27a). Finally, Petitioner submitted a petition for certiorari and again asked for a decision on this issue. This Court denied that petition. (App. 29a).

Having exhausted all remedies to have this issue addressed, Restorative Care of America, Incorporated applies to this Court pursuant to the provisions of 28 U.S.C. § 1651 and Supreme Court Rule 20, for a Writ of Mandamus to the Court of Appeals for the Federal Circuit, directing that judgment be rendered on the issue of whether patent reexamination can be broadened beyond the new question of patentability set forth in the reexamination order under 35 U.S.C. § 304.

REASONS FOR GRANTING THE WRIT

When an appeal is properly before a court, there exists a duty to decide all issues presented. *See Epperson v. Arkansas*, 393 U.S. 97, 102 (1968). As Chief Justice Marshall said:

> The judiciary cannot, as the legislature may, avoid a measure, because it approaches the confines of the constitution. We cannot pass it by, because it is doubtful. With whatever doubts, with whatever difficulties, a case may be attended, we must decide it, if it be brought before us. We have no more right to decline the exercise of jurisdiction which is given, than to usurp that which is not given. . . . Questions may occur, which we would gladly avoid; but we cannot avoid them. All we can do is to exercise our best judgment, and conscientiously to perform our duty.

Cohens v. Virginia, 19 U.S. (6 Wheat) 264, 404 (1821).

A failure to adjudicate a critical part of a case has consistently been found to merit the issuance of a Writ of Mandamus. *See generally, United States East Telecommunications v. United States West Information Systems,* 15 F.3d 261, 263 (2d Cir. 1994) (recognizing that the right of a movant to have a motion decided is so clear that it will be enforced under proper circumstances by mandamus); *In re School Asbestos Litigation*, 977 F.2d 764, 793 (3d Cir. 1992) (finding that a court's failure to consider the merits of a summary judgment motion is a failure to exercise its authority when it has the duty to do so).

The Federal Circuit, in refusing to decide an issue squarely on appeal, has breached its duty to decide all issues presented.

Not only would a favorable decision have changed completely the outcome of the Court's order regarding the validity of Petitioner's '013 patent, but this issue of limiting the scope of reexamination to the new question of patentability specified in the reexamination order will affect every reexamination in the future, as it has affected many in the past. As a result of the Federal Circuit's refusal to decide, patent owners involved in reexamination will continue to be forced to start over to resecure their patent when the statute is directed only to the resolution of a new question of patentability identified in the reexamination order. *See In re Etter*, 756 F.2d 852, 860 (Fed. Cir.) (Nies, J. concurring), *cert. denied*, 474 U.S. 828 (1985).

The issue has further importance in that there is pending litigation in the U.S. District Court of Florida for infringement of the '013 patent, which has been stayed pending the resolution of the reexamination. (App. 31a).

The Petitioner has exhausted every possible remedy to have this important issue decided. The Federal Circuit is the only Appellate Court for patent issues. *See* 28 U.S.C. § 1295 (1995). Petitioner squarely placed the issue before the Court, yet no decision was made. Petitioner has petitioned for a rehearing or rehearing *en banc* which was refused without comment. Further, Petitioner submitted a petition for Writ of Certiorari to this Court which was denied. Despite these efforts, no ruling on an issue which would change the outcome of the case has been made and the Patent Office is left free to conduct a reexamination at the discretion of an examiner. *Id.* at 856 (noting that the Patent Office "should not merely allow reexamination to proceed in any direction at the discretion of an examiner.").

Petitioner properly presented the issue before the Federal Circuit as a matter of right. (App. 24a). Thus, the Federal Circuit's refusal to consider whether the scope of reexamination

can be broadened to consider patentability issues beyond those set in the reexamination order represents the type of extraordinary circumstances under which a Writ of Mandamus is warranted. Because Petitioner has exhausted all other remedies available, it respectfully requests that this Court issue the Writ of Mandamus to compel the Federal Circuit to exercise the obligation for which it has a duty.

Respectfully submitted,

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APPENDIX A — DECISION OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DECIDED JULY 8, 1997

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

96-1101,-1123,-1124
(Serial No. 08/218,756)
IN RE ROBERT LONARDO

(Reexamination No. 90/003,494)
IN RE RESTORATIVE CARE

(Reexamination No. 90/003,343)
IN RE RESTORATIVE CARE

Kirk M. Hartung, Zarley, McKee, Thomte, Voorhees & Sease, of Des Moines, Iowa, argued for appellants. With him on the brief was *Donald H. Zarley*.

Nancy J. Linck, Solicitor, U.S. Patent and Trademark Office, of Arlington, Virginia, argued for the Commissioner. With her on the brief were *Albin F. Drost*, Deputy Solicitor, *Joseph G. Piccolo* and *John M. Whealan*, Associate Solicitors.

Appealed from: U.S. Patent and Trademark Office
Board of Patent Appeals and Interferences

Appendix A

United States Court of Appeals for the Federal Circuit

96-1101,-1123,-1124
(Serial No. 08/218,756)
IN RE ROBERT LONARDO

(Reexamination No. 90/003,494)
IN RE RESTORATIVE CARE

(Reexamination No. 90/003,343)
IN RE RESTORATIVE CARE

DECIDED: July 8, 1997

Before NEWMAN, LOURIE, and RADER, *Circuit Judges*.

Opinion for the court filed by *Circuit Judge* LOURIE. Opinion concurring in the judgment as to Serial No. 08/218,756 and dissenting as to Reexamination Nos. 98/003,494 and 90/003,343 filed by *Circuit Judge* NEWMAN.

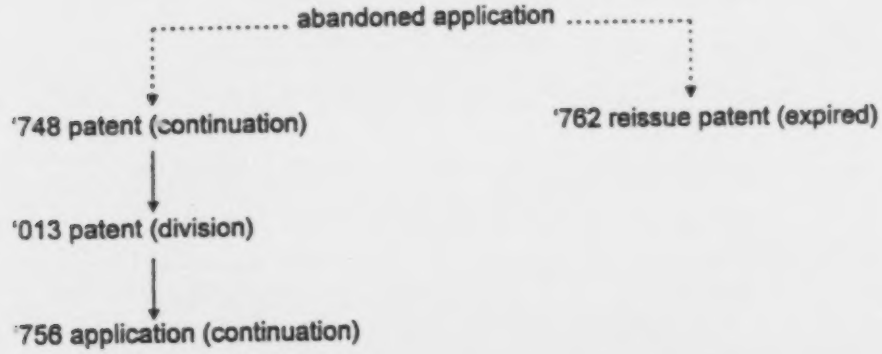
LOURIE, *Circuit Judge*.

Robert Lonardo and Restorative Care of America Inc. appeal from three decisions of the Patent and Trademark Office (PTO) Board of Patent Appeals and Interferences holding that certain claims of U.S. Patents 5,269,748 and 5,298,013 are invalid, and that the only claim of application S/N 08/218,756 is not allowable, based on the ground of double patenting over expired U.S. Patent Re. 33,762. *Ex parte Restorative Care of Am., Inc.*, No. 95-4499 (Bd. Pat. App. & Int. Oct. 13, 1995); *Ex parte Restorative Care of Am., Inc.*, No. 95-4500 (Bd. Pat. App. & Int. Oct. 13, 1995); *Ex parte Lonardo*, No. 95-4476 (Bd. Pat.

App. & Int. Oct. 13, 1995). Because the board did not err in holding that the rejected claims of the patents are unpatentable and that the claim of the application is not allowable, we affirm.

BACKGROUND

The '756 application is a continuation of the application that issued as the '013 patent, which is a division of the application that issued as the '748 patent. The '013 and '748 patents, the '756 application, and the '762 patent are all apparently entitled to the benefit of the filing date of the same abandoned application. The following chart indicates the relationship between these patents and applications.



The inventions of the patents and application generally concern a therapeutic leg and foot device. As shown in figure 8 of the application and patents, reproduced below, this device includes an L-shaped member having a leg portion (20), a heel portion (22) at the end of the leg portion, and a foot portion (21) extending from the heel portion at a right angle to the leg portion. The heel portion is configured to provide a space (27) between a patient's heel and the heel portion (22) in order to prevent the application of pressure to the patient's heel. This is useful, for

example, in preventing the formation of a decubitus ulcer (pressure sore) on the heel of a bedridden patient.

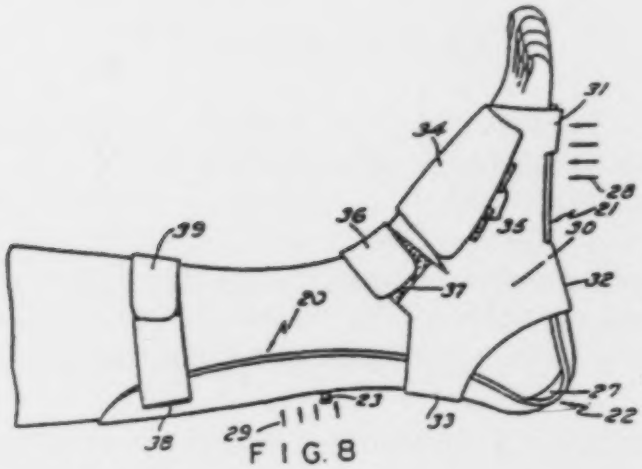


FIG. 8

Claim 1 of the expired '762 reissue patent reads as follows:

> 1. A therapeutic leg and foot device comprising an L-shaped member of a flexible, transparent, acrylic, plastic, said member having a generally contoured and channel-shaped leg portion, a curved heel portion integral with one end of said leg portion, and a generally contoured foot portion extending integrally from said heel portion at right angles to said leg portion, said foot portion being shorter than the adult human foot, the channel shape of said leg portion being substantially flattened at said heel portion, said curved heel portion being narrower than said foot and leg portions and having a free and unflanged edge to permit

Appendix A

> flexing of said foot portion with respect to said leg portion, said foot portion exerting a pressure of 30 to 50 lbs. toward said leg portion when said foot portion is flexed away from the right angle position, and means for releasably securing the device to the leg and foot of a patient.

The '748 patent also claims a device, claims 1 and 9 reading as follows:

> 1. A therapeutic leg and foot device, comprising, an L-shaped member comprised of a one piece flexible plastic material;
>
> said L-shaped member having a leg portion, a heel portion integral with one end of said leg portion, and a foot portion extending integrally from said heel portion at right angles to said leg portion,
>
> said heel portion having a configuration to provide a space between the patient's heel and said heel portion to prevent the application of pressure to the patient's heel by the heel portion when the posterior region of the lower leg and the sole of the foot of a patient wearing the device are in supporting contact with said leg portion and said foot portion, respectively, resulting from the configuration of said heel portion,
>
> said heel portion having substantially free and unflanged side edges to permit lateral

visibility of said space and a patient's heel suspended within said space, and

means for releasably securing said device to the leg and foot of a patient.

9. The device of claim 1 wherein said means for releasably securing said device to the leg and the foot of a patient is comprised of a sandal extending substantially over said foot portion and the foot of the patient with a cut out heel portion adjacent said heel portion of said splint and said space.

Restorative Care stated in its brief that claim 11 "is substantially similar to claim 9, except there is no limitation in claim 10 (from which claim 11 depends) that the L-shaped member be a one piece plastic material (as in claim 1 from which claim 9 depends)."

The '013 patent claims a method, claim 1 reading as follows:

1. The method of healing or preventing decubitus on the heel of a bedfast patient, comprising,

placing on the leg and foot of said patient an L-shaped member having a leg portion, a heel portion on one end of said leg portion, and a foot portion extending from said heel portion at right angles to said leg portion,

forming the shape of said heel portion so that the shape alone of said heel portion will

provide a space between the patient's heel and said heel portion to prevent the application of pressure to the patient's heel by said heel portion when the lower leg and the sole of the foot of said patient are in intimate contact with said leg portion and said foot portion, respective,

and securing said L-shaped member to the leg and foot of said patient by using a sandal extending substantially over said foot portion and the foot of the patient, and cutting out a heel portion of said sandal adjacent said heel portion of said L-shaped member and said space.

The '756 application also claims a method, claim 1 reading as follows:

1. The method of healing or preventing decubitus on the heel of a bedfast patient, comprising,

placing on the leg and foot of said patient an L-shaped member having a leg portion, a heel portion secured to one end of said leg portion, and a foot portion extending from said heel portion substantially at right angles to said leg portion,

forming the shape of said heel portion so that the shape alone of said heel portion alone will provide a space between the heel portion

> and said heel of said patient to prevent the application of pressure to the patient's heel by said heel portion when the lower leg and the sole of the foot of said patient are in intimate contact with said leg portion and said foot portion, respectively,
>
> securing said L-shaped member to the leg and foot of said patient by using a sandal extending substantially over said foot portion, and the foot of the patient,
>
> and providing an opening in said sandal adjacent said heel portion of said L-shaped member and said space to permit visual inspection of said space from a lateral direction.

Third parties requested reexamination of the '748 and '013 patents; the reexaminations were limited to claims 9 and 11 of the '748 patent and claims 1, 2, and 5 of the '013 patent. The reexamination order for the '748 patent was based on a new question of patentability allegedly raised with respect to the '762 patent, and the reexamination order for the '013 patent was based on a new question of patentability allegedly raised with respect to another patent. During reexamination, the claims in question of both patents were rejected on the ground of double patenting over claim 1 of the '762 patent. Restorative Care appealed to the board, arguing that double patenting was improperly raised during reexamination and that the claims in question are patentably distinct over claim 1 of the '762 patent.

The board first determined that the issue of double patenting was properly raised during reexamination of the '748 patent. It

reasoned that under 35 U.S.C. § 303 (1994), the Commissioner has the authority to consider "other patents" during reexamination, aside from "prior art consisting of patents or printed publications" specified in 35 U.S.C. § 301 (1994). The board in effect interpreted the phrase "other patents" in section 303 as not being limited to prior art patents. It affirmed the rejection of claims 9 and 11 of the '748 patent on the ground of obviousness-type double patenting over claim 1 of the '762 patent. The board reasoned that obviousness-type double patenting includes all types of double patenting other than "same invention" double patenting. Since the claims in question did not define identical subject matter, the board held that "same invention" double patenting did not apply, but obviousness-type double patenting was properly applied because one could not practice the invention of the expired '762 patent without infringing the '748 patent.

The board's analysis next focused on the "securing" means limitation of claims 9 and 11. In construing that limitation under 35 U.S.C. § 112, ¶ 6 (1994), the board found that the only structure disclosed for that means was a sandal with a cut-out heel portion. The board thus concluded that the claims of the '762 and '748 patents both require that structure and accordingly that they are not patentably distinct. The board also affirmed the rejection of claims 1, 2, and 5 of the '013 patent on the ground of double patenting over claim 1 of the '762 patent. The board found that the "securing" step requires securing a sandal with a cut-out heel portion and again interpreted the "securing" means of the '762 patent claim as requiring a sandal with a cut-out heel portion. The board therefore concluded that the method of the '013 patent is not patentably distinct from the apparatus of the '762 patent.

Finally, the sole claim of the '756 application was rejected on the ground of double patenting over claim 1 of the '762 patent. The board found that the claimed method of the '756 application requires use of a sandal with a cut-out heel portion. Because the apparatus of the '762 patent requires that same structure, the board concluded that the method was not patentably distinct over the apparatus.

Lonardo and Restorative Care appealed to this court and all three cases were consolidated for appeal. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(4) (1994). Double patenting is a question of law that we review *de novo*. *Texas Instruments v. United States Int'l Trade Comm'n*, 998 F.2d 1165, 1179, 26 USPQ2d 1018, 1029 (Fed. Cir. 1993).

DISCUSSION

A. *Propriety of Reexamination*

Restorative Care argues that there was no basis for reexamination of the '748 patent, that reexamination may only be ordered to decide new questions of patentability based upon prior art. Because the '762 and '748 patents are entitled to the same filing date, Restorative Care argues, the '762 patent is not prior art to the '748 patent and the reexamination thus was improper. The PTO responds that the Commissioner is authorized to consider double patenting during reexamination. In particular, the PTO argues that the reexamination statute authorizes the Commissioner to consider "other patents or printed publications" without restriction to prior art. The PTO also argues that, because obviousness-type double patenting is judicially-created and is not based upon statute, there is no statutory reason why it may not be applied in both examination and reexamination.

Appendix A

The doctrine of double patenting is intended to prevent a patentee from obtaining a time-wise extension of patent for the same invention or an obvious modification thereof. *E.g.*, *In re Longi*, 759 F.2d 887, 892, 225 USPQ 645, 648 (Fed. Cir. 1985). "Same invention" double patenting is based upon 35 U.S.C. § 101 (1994), which states that an inventor may obtain "a patent" for an invention. The statute thus permits only one patent to be obtained for a single invention, and the phrase "same invention" refers to an invention drawn to substantially identical subject matter. *Id.* Obviousness-type double patenting, on the other hand, is judicially created and prohibits an inventor from obtaining a second patent for claims that are not patentably distinct from the claims of the first patent. *Id.* With obviousness-type double patenting, however, a terminal disclaimer may overcome that basis for unpatentability, assuming that the first patent has not expired. In this case, the '762 patent, over which the claims have been rejected, has expired, so a terminal disclaimer cannot cure these rejections.

The applicable statute relating to reexamination provides that:

> Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Commissioner will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. On his own initiative, and any time, the Commissioner may determine whether a substantial new question of

> patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title.

35 U.S.C. § 303(a) (1994).

Under section 303(a), the Commissioner has authority "[o]n his own initiative" to consider a substantial new question of patentability over "patents and publications discovered by him." That provision of the statute is not specifically limited to prior art patents or printed publications. Moreover, it authorizes the Commissioner to consider "other patents or printed publications" in addition to the prior art submitted by a third party who may have requested the reexamination. *See* 35 U.S.C. § 301 (1994) ("Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent."); 35 U.S.C. § 302 (1994) ("Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title."). Since the statute in other places refers to prior art in relation to reexamination, *see id.*, it seems apparent that Congress intended that the phrases "patents and publications" and "other patents or printed publications" in section 303(a) not be limited to prior art patents or printed publications.

The legislative history indicates that considerations such as cost and availability of evidence were among the criteria Congress considered in determining the scope of reexamination. *See* H.R. Rep. No. 1307, at 4 (1980), *reprinted in* 1980 U.S.C.C.A.N. 6460, 6462-63; *see also Quad Envtl. Techs. Corp. v. Union Sanitary Dist.*, 946 F.2d 870, 875 n.7, 20 USPQ2d 1392,

1395 n.7 (Fed. Cir. 1991) (stating that the purpose in restricting reexamination to printed documents "was to provide a cheaper and less time-consuming alternative way to challenge patent validity on certain issues"). A patent is clearly the type of evidence that Congress intended the PTO to consider during reexamination, and the cost of examination is not significantly increased by having the PTO consider the ground of double patenting, as it involves issues of claim identity and obviousness, well within the PTO's everyday expertise. The burdens on the patentee and the PTO are the same, whether the issue is novelty or nonobviousness over prior art patents or double patenting over a prior-issued patent. Moreover, the efficiency of the patent evaluation process is ultimately increased by allowing the PTO to consider double patenting during reexamination, rather than requiring a district court to decide a challenge to a patent based upon alleged double patenting. Finally, it is reasonable to conclude that Congress intended to include double patenting over a prior patent as a basis for reexamination because maintenance of a patent that creates double patenting is as much of an imposition on the public as maintenance of a patent that is unpatentable over prior art. Thus, we conclude that the PTO was authorized during reexamination to consider the question of double patenting based upon the '762 patent.

Restorative Care also argues that, even if the PTO was entitled to consider double patenting during reexamination, the examiner improperly relied upon a "nonobvious double patenting" ground. It refers to the examiner's reasoning that the patentee should not be entitled to maintenance of the rejected claims because it did not show why the claims were not presented in the earlier patent and the subject matter of the claims was fully disclosed in that patent. Restorative Care argues that there are only two types of double patenting, same invention and

obviousness-type, and that the board improperly affirmed the rejection based upon a nonexistent class of double patenting. The PTO responds that the board properly relied upon obviousness-type double patenting by finding that the '748, '013, and '762 claims are only obvious variations of each other.

We note that the Manual of Patent Examining Procedure contains a section entitled "Nonobvious Type" within its discussion of nonstatutory double patenting. M.P.E.P. § 804(B)(2), p. 800-20 (July 1996). It refers to the questions whether claims could have been presented in an earlier patent and whether the subject matter is disclosed in that patent. Both issues were mentioned by the board here. However, we need not consider whether Restorative Care is correct in its assertion that its claims were improperly rejected on the basis of a nonobvious double patenting ground. The board premised its affirmance of the examiner on obviousness-type double patenting and we agree with its holding, as is indicated hereinbelow.

B. *Obviousness-Type Double Patenting*

1. *The '748 Patent*

Restorative Care argues that claims 9 and 11 of the '748 patent are patentably distinct from claim 1 of the '762 patent and that, accordingly, obviousness-type double patenting does not bar confirmation of its claims. In particular, it argues in its brief (emphasis in original) that, although all claims in question "require an L-shaped member with a leg portion, a heel portion, and a foot portion integral with one another," claim 1 of the '762 patent

> further requires that the L-shaped member be made from *transparent acrylic plastic*, that the foot and leg portions be *contoured*, that the foot portion be *shorter* than the adult human foot, that the leg portion be substantially *flattened* at the heel portion, that the heel portion be *narrower* than the leg and foot portions, and that the foot portion exert a pressure of *30-50* pounds.

The PTO responds that claims 9 and 11 of the '748 patent contain only obvious variations over claim 1 of the '762 patent and that one could not practice the invention of claim 1 of the '762 patent without also infringing claims 9 and 11.

We agree with the PTO that the claims in question are unpatentable on the ground of obviousness-type double patenting, not because one could not practice the invention of the '762 patent without infringing claims 9 and 10, but because each of the additional limitations argued by Restorative Care is an obvious modification of the device defined in the '762 claim. Many of the alleged differences in elements are in species-genus form, the expired '762 patent claiming an element with specificity and the '748 claims defining it more generically. For example, Restorative Care has shown no patentable distinction between a "leg portion" ('748 patent) and a "generally contoured and channel-shaped leg portion" ('762 patent), between a "foot portion" and a "generally contoured foot portion," or between a "heel portion" and a "curved heel portion."

Restorative Care also argues that the board improperly read limitations into the specification when it interpreted the "securing" means limitation of the '762 patent claim. The PTO

responds that, under 35 U.S.C. § 112, ¶ 6 (1994), the board correctly considered the specification in construing the "securing" means element. *See In re Donaldson*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1849 (Fed. Cir. 1994) (in banc) (stating that section 112, ¶ 6, "applies regardless of the context in which the interpretation of means-plus-function language arises"). We agree with the PTO that the board correctly interpreted the "securing" means element under section 112, ¶ 6, and *Donaldson*. The only structure disclosed for implementing the function of the "securing" means is a sandal with a cut-out heel portion. In particular, the specification states that:

> Any suitable means may be used to secure the device to the leg and foot of the patient. For example, viewing FIGS. 8 and 9, I use a soft leather sleeve or sandal 30 which is slipped over the patient's foot and the foot portion 21 of the device. It is provided with a cut out heel portion with strips 31 and 32 passing under the foot and strips 33 behind the upper heel.

'762 patent, col. 3, lines 55-62. In interpreting the "securing" means in light of the disclosed structure, we do not disagree with the board that it must be interpreted in the manner that is expressly recited in claim 9 of the '748 patent. Accordingly, the board did not err in concluding that claims 9 and 11 of the '748 patent are unpatentable on that ground.

2. *The '013 Patent*

Restorative Care makes the same arguments with respect to this patent. For the reasons explained above, double patenting

was properly raised during reexamination of the '013 patent. Furthermore, the board correctly characterized the rejection as being based on obviousness-type double patenting.

Restorative Care argues that the claims in question are patentably distinct from the claims of the '762 patent. Restorative Care argues that the method of using the device would not have been obvious over a claim to the device. We do not agree that there is a patentable distinction between the method of using the device and the device itself. The claimed structure of the device suggests how it is to be used and that use thus would have been obvious.

Restorative Care also argues that the particular structure used by the method is patentably distinct from the device, and it makes essentially the same arguments with respect to the alleged structural differences as it did for the '748 patent. For the reasons explained above, we agree with the PTO that, even given these structural differences, the method would have been obvious. Accordingly, we conclude that the board did not err in holding that claims 1, 2, and 5 of the '013 patent are unpatentable on the ground of double patenting over the '762 patent.

3. *The '756 Application*

Lonardo finally argues that the claim of the '756 application is patentably distinct from the '762 patent claim. The PTO responds that the board correctly rejected the claim on the ground of obviousness-type double patenting. Lonardo makes essentially the same arguments with respect to the alleged distinctions between the method and device, and between the structure used by the method and the structure of the device, that Restorative Care made with respect to the '748 and '013

patents. For the reasons explained above, we do not agree that these are nonobvious distinctions or that there is such a distinction between the method of using the device and the device itself. Accordingly, we conclude that the board did not err in holding that the claim of the '756 application is unpatentable over the '762 patent on the ground of double patenting.

CONCLUSION

The board did not err in concluding that double patenting was properly raised during reexamination of the '748 and '013 patents and that claims 9 and 11 of the '748 patent and claims 1, 2, and 5 of the '013 patent are unpatentable over the '762 patent on the ground of obviousness-type double patenting. The board also did not err in concluding that claim 1 of the '756 application is not allowable on that same ground.

AFFIRMED

Appendix A

United States Court of Appeals for the Federal Circuit

96-1101, -1123, -1124

(Serial No. 08/218,756)
IN RE ROBERT LONARDO

(Reexamination No. 98/003,494)
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(Reexamination No. 90/003,343)
IN RE RESTORATIVE CARE

NEWMAN, *Circuit Judge*, concurring in the judgment as to Serial No. 08/218,756, dissenting as to Reexamination Nos. 98/003,494 and 90/003,343.

Double patenting is not a ground of rejection that is permitted to be raised under the reexamination statute. I must, respectfully, dissent from the panel majority's decision to ignore the statutory limitations of reexamination.

The reexamination statute is the result of a carefully designed compromise, balancing the advantages of resolution of certain important issues by reexamination in the Patent and Trademark Office, against the disadvantages of potential harassment of patentees after their patent has issued. For this reason, the statute requires that reexamination be limited to "prior art consisting of patents or printed publications" cited to the Office under 35 U.S.C. §301. Section 302 authorizes a request for reexamination "on the basis of any prior art cited under the provisions of section 301," and states that the request "must set forth the pertinency and manner of applying cited prior

art." Patentability based on prior art is the only available ground of reexamination.[1]

Double patenting is not based on prior art. *See, e.g., Quad Environmental Tech. Corp. v. Union Sanitary Dist.*, 946 F.2d 870, 874, 20 USPQ2d 1392, 1394 (Fed. Cir. 1991) (a double patenting rejection "does not mean that the first-filed patent is a prior art reference under §102 against the later-filed application. [Citation omitted.]"); *In re Kaplan*, 789 F.2d 1574, 1579, 229 USPQ 678, 682 (Fed. Cir. 1986) ("In considering the question [of obviousness-type double patenting], the patent disclosure may not be used as prior art. [Citation omitted.]"); *In re Longi*, 759 F.2d 887, 892 n.4, 225 USPQ 645, 648 n.4 (Fed. Cir. 1985) ("the patent principally underlying the double patenting rejection is not considered prior art. [Citation omitted.]").

Limitation of reexamination to prior art was the legislative response to concerns lest the life of an issued patent be wasted and the patentee's legitimate rights be abused by third party requests for reexamination, for there are myriad grounds on which patentability is subject to challenge. *See Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 601, 225 USPQ 243, 248 (Fed. Cir. 1985). In *In re Recreative Technologies Corp.*, 83 F.3d 1394, 1397, 38 USPQ2d 1776, 1778 (Fed. Cir. 1996) this court reviewed the legislative history and its "serious concern that reexamination not create new opportunities for abusive tactics and burdensome procedures." The requirement that "[n]o grounds of reexamination were to be permitted other than on

1. The panel majority's suggestion that the Commissioner's authority to act "on his own initiative," 35 U.S.C. §303(a), somehow enlarges the grounds of reexamination is not a tenable reading of the statute.

new prior art and sections 102 and 103" was a well-considered balance of the arguments for and against reexamination. H.R. Rep. No. 96-1307, at 3 (1980), *reprinted in* 1980 U.S.C.C.A.N. 6460, 6462 (reexamination is limited to new prior art).

The court again explained in *In re Portola Packaging, Inc.*, 110 F.3d 786, 789, 42 USPQ2d 1295, 1298 (Fed. Cir. 1997) that "Congress recognized that holdings of patent invalidity by courts were mostly based on prior art that was not before the PTO." (Citing *Patent Reexamination: Hearings on S.1679 before the Senate Comm. on the Judiciary*, 96th Cong. 14 (1980) (testimony of Commissioner Sidney Diamond) (referring to a 1974 study showing that 66-80% of the patents held invalid involved uncited prior art)). *See In re Etter*, 756 F.2d 852, 856, 225 USPQ 1, 4 (Fed. Cir. 1985) (*in banc*) (the purpose of reexamination is to remedy overlooked prior art).

To achieve a contrary holding for the ground of double patenting, my colleagues invoke "efficiency" and offer the explanation that reexamination is cheaper and less burdensome than litigation. However, these were not the only issues weighed and balanced in this legislation, for a primary concern was the encumbrance on the patent during reexamination proceedings. Indeed, here it is the patentee who is objecting to having been brought into involuntary reexamination by third parties while the patents are in litigation.

It is not our role to amend the statute, and it is not our privilege to ignore the statute. Indeed, I take note that Congress has recently held hearings on certain proposals to enlarge the scope of reexamination. Meanwhile, the statute continues to bar reexamination on the ground of double patenting.

APPENDIX B — JUDGMENT OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DATED JULY 8, 1997

United States Court of Appeals for the Federal Circuit

96-1101,-1123,-1124

(Serial No. 08/218,756)
IN RE ROBERT LONARDO

(Reexamination No. 90/003,494)
IN RE RESTORATIVE CARE

(Reexamination No. 90/003,343)
IN RE RESTORATIVE CARE

JUDGMENT

ON APPEAL from the UNITED STATES PATENT AND TRADEMARK OFFICE BOARD OF PATENT APPEALS AND INTERFERENCES

in Case NO(S). 08/218/756, 90/003,494, 90/003/343

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

AFFIRMED

Appendix B

ENTERED BY ORDER OF THE COURT

DATED JUL 08 1997

s/ Jan Horbaly
Jan Horbaly, Clerk

ISSUED AS A MANDATE: September 5, 1997

APPENDIX C — EXCERPTS FROM PETITIONER'S APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT FILED AUGUST 2, 1996

B. The Scope of The Reexamination of the '013 Was Improperly Broadened Beyond the New Question of Patentability of The Reexamination Order

The Reexamination order (A119-121) for the '013 patent states that the Baker patent cited in the reexamination request raises a substantial new question of patentability. No other new questions of patentability are set forth in the order. (A119-121). However, the '013 reexamination proceeded, and is on this appeal based upon a different question of patentability, namely double patentability.

35 U.S.C. § 304 provides that if the Commissioner finds that a substantial new question of patentability affecting any claim of the patent is raised, "the determination will include an order for reexamination of the patent *for* . . .

APPENDIX D — EXCERPTS FROM PETITION FOR REHEARING AND SUGGESTION OF REHEARING EN BANC TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT FILED JULY 22, 1997

B. The Court Failed To Decide The Issue Of Whether The Substantial New Question Of Patentability On Which The Order Of Reexamination Of The '013 Patent Was Based Can Be Supplemented After The Order Was Issued To Include Other Questions Of Patentability During The Reexamination Process

The reexamination order for the '013 patent was premised upon a new question of patentability in view of the Baker patent. (A119-121). However, the PTO ignored the reexamination order, and decided the '013 reexamination on the double patenting issue which was *not* in the order. Appellants appealed the impropriety of this action, but this Court failed to address or to decide this issue, which was set forth at page 1 of Appellant's primary brief and discussed at pages 15-19.

If this issue had been considered and decided in Appellants favor, the Court's adverse decision finding the '013 patent invalid by reason of double . . .

APPENDIX E — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DENYING PETITION FOR REHEARING FILED AUGUST 29, 1997

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

96-1101,-1123,-1124

(Serial No. 08/218,756)
IN RE ROBERT LONARDO

(Reexamination No. 90/003,494)
IN RE RESTORATIVE CARE

(Reexamination No. 90/003,343)
IN RE RESTORATIVE CARE

ORDER

Appendix E

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

ORDER

A combined petition for rehearing and suggestion for rehearing in banc having been filed by the APPELLANT, and a response thereto having been invited by the court and filed by the APPELLEE, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the suggestion for rehearing in banc and response having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is DENIED and it is further

ORDERED that the suggestion for rehearing in banc be, and the same hereby is, DECLINED.

The mandate of the court will issue on September 5, 1997.

FOR THE COURT,
JAN HORBALY, CLERK

Appendix E

Dated: August 29, 1997

By s/ Alex Van Veen
Alex Van Veen
Staff Law Clerk

cc: KIRK M. HARTUNG
NANCY J. LINCK

IN RE LONARDO, 96-1101,-1123,-1124
(PTO - 08/218,756)

Note: Pursuant to Fed. Cir. R. 47.6, this order is not citable as precedent. It is a public record.

APPENDIX F — ORDER OF THE UNITED STATES SUPREME COURT DENYING PETITION FOR WRIT OF CERTIORARI FILED MARCH 2, 1998

SUPREME COURT OF THE UNITED STATES
OFFICE OF THE CLERK
WASHINGTON, D.C. 20543

March 2, 1998

Mr. Donald Hoyt Zarley
801 Grand Avenue
Suite 3200
Des Moines, IA 50309

Re: In Re Robert Lonardo and Restorative Care of America, Inc. No. 97-892

Dear Mr. Zarley:

The Court today entered the following order in the above entitled case:

The petition for a writ of certiorari is denied.

Sincerely,

William K. Suter, Clerk

APPENDIX G — ORDER GRANTING STAY PENDING THE OUTCOME OF THE FEDERAL CIRCUIT APPEAL FROM THE UNITED STATES DISTRICT COURT, MIDDLE DISTRICT OF FLORIDA, TAMPA DIVISION, ISSUED MARCH 4, 1998

UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF FLORIDA
TAMPA DIVISION

CASE NO. 96-1321-CIV-T-21-E

RESTORATIVE CARE OF AMERICA, INC.,

Plaintiff,

v.

BRUCE A LEHMAN, ASSISTANT SECRETARY OF COMMERCE AND COMMISSIONER OF PATENTS AND TRADEMARKS,

Defendant.

ORDER

Appendix G

Filed herein are Plaintiff's Response (Dkt. 8) to this Court's January 13, 1997, Order to Show Cause (Dkt. 7) as well as Defendant's Notice of the Pendency of Other Actions (Dkt. 6).

In this action, which relates to the term of certain of Plaintiff's patents, Plaintiff seeks a writ of mandamus compelling the Defendant to cancel, withdraw, waive or suspend certain terminal disclaimers. Previously filed in this Court are two other actions involving Plaintiff, discussed below, that relate to the validity of certain of Plaintiff's patents. Both of these latter cases are currently stayed pending the outcome of appeals pending before the Federal Circuit.

By Order (Dkt. 7) of January 13, 1997, the Court directed Plaintiff to show cause, by a written response filed with the Clerk of Court within eleven days of the date thereof, why this case should not be dismissed for lack of prosecution, pursuant to Rule 3.10, Local Rules, Middle District of Florida, based on Plaintiff's failure to file a Case Management Report within the period described by Local Rule 3.05. Based on the issues discussed in Plaintiff's Response (Dkt. 8) to this Order and the transfer of this case, discussed below, the Court will discharge the Order to Show Cause (Dkt. 7).

As regards Defendant's Notice of Pendency of Other Actions, review of the case file reveals that this action involves questions of law or fact common to those in cases number 93-1968-CIV-T-25-A AND 94-0265-CIV-T-25-C, currently pending before the Honorable Henry L. Adams. Therefore, this cause will be transferred to Judge Adams, with his consent, for all further proceedings in accordance with Local Rule 1.04(b), Middle District of Florida.

Appendix G

Upon consideration thereof, it is hereby **ORDERED** that:

1. The Court's January 13, 1997, Order to Show Cause (Dkt. 7) is **DISCHARGED**.

2. This cause is **TRANSFERRED** to Judge Adams, with his consent, for all further proceedings in accordance with Local Rule, 1.04(b), Middle District of Florida.

DONE AND ORDERED, at Tampa, Florida, this ____ day of April, 1998.

RALPH W. NIMMONS, JR.
UNITED STATES DISTRICT
JUDGE

Copies to: Counsel of Record
Rita Cole, Deputy Courtroom Clerk
Margaret Costa, Judicial Assistant